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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,874	03/22/2004	Anand Khubani	1111-214	6617

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EXAMINER

LEE, HWA S

ART UNIT PAPER NUMBER

2877

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,874

Applicant(s)

KHUBANI, ANAND

Examiner

Andrew Hwa S. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

The use of the trademark Command Strips has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" is used to designate a base and a laser and reference character "8" is used to designate a surface and an actuating button. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the

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immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Base 1 and laser 1, [0053], surface 8, actuating button 8...not shown. The examiner has not checked every reference number in the drawings with the reference numbers in the specification and therefore, the examiner urges the Applicant to thoroughly review the drawings.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 ends with "laser path during." and appears to be an incomplete sentence.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1, 2, and 9-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Levine (US 2004/0258126).

With regards to **claim 1**, Levine shows a laser line generating device with a swivel base comprising:

a base (e.g. 28, 102), said base comprising at least one pair of opposing edges, said base capable of being positioned relative to the working surface such that each of said opposing edges is adjacent to the working surface;

an adhesive layer (e.g. 109 + 104), said adhesive layer being situated on said base so as to removably affix said base on the working surface without damaging the working surface; and

an activating switch (“linked internal switch”, not shown), said switch being located on said level at a location offset from said laser path.

Levine teaches two possible ways in which the switch operates. One is a door 20 and a linked internal switch. The other is a where the door 20 is a switch. In the first situation, the linked internal switch would not block the laser light thus meeting the claimed limitation “a location offset from said laser path.” Otherwise, if the switch was not offset from the path of the laser path, the switch would block laser light. Even in Levine’s second embodiment of the switch where the door 20 is a switch, in the situation where the laser light is on by having the door open (Figure 1), this position of the door/switch meets the claimed limitation “a location offset from said laser path.”

With regards to **claim 2**, the top portion of swivel base 102 has a recess, and the adhesive layer (109 + 104) is substantially within the recess.

With regards to **claim 9**, Levine shows a laser line generating device with a swivel base comprising:

a base (e.g. 28, 104), said base comprising at least one pair of opposing edges, and adapted to be positioned adjacent to the working surface such that said opposing edges each engage the working surface;

a tack (e.g. 26), for piercing a surface to provide orientation control to said level; and

an activating switch (“linked internal switch”, not shown), said switch being situated at a location offset from said

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laser path during.

Levine teaches two possible ways in which the switch operates. One is a door 20 and a linked internal switch. The other is a where the door 20 is a switch. In the first situation, the linked internal switch would not block the laser light thus meeting the claimed limitation “a location offset from said laser path.” Otherwise, if the switch was not offset from the path of the laser path, the switch would block laser light. Even in Levine’s second embodiment of the switch where the door 20 is a switch, in the situation where the laser light is on by having the door open (Figure 1), this position of the door/switch meets the claimed limitation “a location offset from said laser path.”

With regards to claim 10, Levine shows a recess (e.g. 54) and tack (e.g. 26).

With regards to claims 11-13, Levine shows all the limitations as demonstrated above but does not expressly show an embodiment where the switch is on the side of a ergonomically shaped level. Official Notice is taken that buttons or switches on the side and shaping a hand held device is well known in the art. At the time of the invention, one of ordinary skill in the art would have placed the button on the side for ergonomic reasons since having a button at a convenient location would ease turning on and off the laser, as is known to do with devices like laser pointers. Furthermore, it has been held that rearranging parts of an invention only requires routine skill in the art. In re Japikse, 86 USPQ 70. In addition, changing the shape of the housing is a matter of design choice and since applicant has not disclosed that the shape solves any stated problem or is for any particular purpose and it appears that the invention would

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perform equally with a different shape. Therefore, the shape lacks criticality in the claimed invention since it does not produce unexpected or novel results.

With regards to claim 14, Levine shows the liquid levels (16, 18, 103).

With regards to claim 15, Levine shows a base (e.g. 28, 30, 102, 104).

With regards to claim 16, Levine shows a notch (e.g. 56, 117).

With regards to claim 17, Levine shows a recess (e.g. 54) and tack (e.g. 26).

3. **Claim 2** is rejected under 35 U.S.C. 102(e) as being anticipated by Wheeler et al (US 2005/0022399).

Wheeler et al. ("Wheeler" hereinafter) show a laser level comprising:

a base (e.g. 104), said base comprising at least one pair of opposing edges, said base capable of being positioned relative to the working surface such that each of said opposing edges is adjacent to the working surface;

an adhesive layer (e.g. 1500), said adhesive layer being situated on said base so as to removably affix said base on the working surface without damaging the working surface, ; and

an activating switch (not shown), said switch being located on said level at a location offset from said laser path (reasons for being offset is the same as applied to claim 1 above).



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wherein said base comprising a recess and said adhesive layer is situated substantially with said recess [0040]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-8, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine as applied in claims 1, 2, and 17 above in view of Wheeler et al (US 2005/0022399).

Levine shows all the limitations as demonstrated above but does not expressly show the adhesive layer in a recess of the base.

Wheeler et al. show a laser level wherein an adhesive is in a recess of the base [0040].

At the time of the invention, a skilled artisan would have modified the base of Levine with a recess for the adhesive layer in order to securely adhere to the attachment surface, avoid overly compressing the adhesive layer, conform we

2) The level of claim 1 wherein said base comprises a recess and wherein said adhesive layer is situated substantially within said recess.

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With regards to claims 3-5, Levine shows all the limitations as demonstrated above but does not expressly show an embodiment where the switch is on the side. Official Notice is taken that buttons or switches on the side and shaping a hand held device is well known in the art. At the time of the invention, one of ordinary skill in the art would have placed the button on the side for ergonomic reasons since having a button at a convenient location would ease turning on and off the laser, as is known to do with devices like laser pointers. Furthermore, it has been held that rearranging parts of an invention only requires routine skill in the art. In re Japikse, 86 USPQ 70.

With regards to claim 6, Levine shows the liquid levels (16, 18, 103).

With regards to claim 7, Levine shows a base (e.g. 28, 30, 102, 104).

With regards to claim 8, Levine shows a notch (e.g. 56, 117).

#### ***2114 [R-1] Apparatus and Article Claims - Functional Language***

Functional recitations have not been given patentable weight since the claims attempt to define the subject-matter in terms of the result to be achieved which merely amounts to a statement of the underlying problem. The claim limitations found in claims 1-19 (i.e. “so as to,” “in order to,”

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“adapted to”) are functional limitations and these limitations can be met by the prior art if the structure of the prior art is capable of performing the claimed functions.

## APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

### *Official Notice*

Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice. Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made by the Board of Patent Appeals and Interferences. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re

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Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well known statement was made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Hwa S. Lee whose telephone number is 571-272-2419. The examiner can normally be reached on Tue-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley Jr. can be reached on 571-272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Andrew Hwa Lee', is positioned above the printed name.

Andrew Hwa Lee  
Primary Examiner  
Art Unit 2877